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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,937	01/26/2004	George R. Kaplan	LKI 205.4	9317
7:	590 08/11/2004		EXAMINER	
Steven M. Hoffberg MILDE & HOFFBERG, LLP			EVANS, GEOFFREY S	
SUITE 460	I beko, eei		ART UNIT	PAPER NUMBER
10 BANK STR WHITE PLAIN	2.2.1		1725 DATE MAILED: 08/11/2004	
WITTEFLAIN	13, INT 10000			

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
Office Action Comments	10/764,937	KAPLAN ET AL.				
Office Action Summary	Examiner	Art Unit				
	Geoffrey S Evans	1725	•			
The MAILING DATE of this communication a Period for Reply	opears on the cover sheet with t	he correspondence addi	ress			
A SHORTENED STATUTORY PERIOD FOR REP THE MAILING DATE OF THIS COMMUNICATION - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a re - If NO period for reply is specified above, the maximum statutory perio - Failure to reply within the set or extended period for reply will, by state Any reply received by the Office later than three months after the mai earned patent term adjustment. See 37 CFR 1.704(b).	l136(a). In no event, however, may a reply ply within the statutory minimum of thirty (30 d will apply and will expire SIX (6) MONTHS tte. cause the application to become ABANC	be timely filed)) days will be considered timely. from the mailing date of this com	munication.			
Status	·					
1) Responsive to communication(s) filed on						
	is action is non-final.		•			
	, / =					
closed in accordance with the practice under						
Disposition of Claims						
4)⊠ Claim(s) <u>126-201</u> is/are pending in the applic	ation					
4a) Of the above claim(s) is/are withdr						
5) Claim(s) is/are allowed.		. *				
6) Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) <u>126-201</u> are subject to restriction ar	d/or election requirement.					
Application Papers	·					
9) The specification is objected to by the Examir	ıor					
		La Constant	•			
10) The drawing(s) filed on is/are: a) ac						
Applicant may not request that any objection to the						
Replacement drawing sheet(s) including the corre						
11) The oath or declaration is objected to by the E	examiner. Note the attached Of	fice Action or form PTO	-152.			
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreig	n priority under 35 U.S.C. § 11	9(a)-(d) or (f).				
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documer						
2. Certified copies of the priority documer						
3. Copies of the certified copies of the pri		eived in this National St	age			
application from the International Bure						
* See the attached detailed Office action for a lis	t of the certified copies not rec	eived.				
Attachmout(s)						
Attachment(s)	, []					
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	4)	nary (PTO-413) il Date				
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) 🔲 Notice of Inform	nal Patent Application (PTO-1	52)			
Paper No(s)/Mail Date	6) Other:					
U.S. Patent and Trademark Office PTOL-326 (Rev. 1-04) Office A	action Summary	Part of Paper No./Mail Date	20040809			

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DETAILED ACTION

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 126-138,150-164, drawn to an apparatus for generating a map of a gemstone, classified in class 219, subclass 121.83.
 - II. Claims 139-149,165-176, drawn to a method of laser marking a gemstone that includes coating, classified in class 219, subclass 121.69.
 - Claims 177-201, drawn to a laser marking unit with focus control, classified in class 219, subclass 121.73.

The inventions are distinct, each from the other because of the following reasons:

- 2. Invention II (a method of laser marking) and Invention I (an apparatus for generating a map of a gemstone) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus for generating a map of a gemstone does not require the gemstone to be coated.
- 3. Invention II (a method of laser marking) and Invention III (a laser marking unit with focus control) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can

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be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the laser marking unit does require the gemstone to be coated.

- 4. Invention I (an apparatus for generating a map of a gemstone) and Invention III (a laser marking unit with focus control) are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as laser cutting. See MPEP § 806.05(d).
- 5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned (703)-872-9306.

GSE

Geoffrey S. Evans
Primary Examiner
Group 1700